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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,898	08/11/2004	Jennifer Fernandez	10939.3801	4897
22235	7590	12/14/2004	EXAMINER	
MALIN HALEY AND DIMAGGIO, PA 1936 S ANDREWS AVENUE FORT LAUDERDALE, FL 33316			MITCHELL, TEENA KAY	
			ART UNIT	PAPER NUMBER

3743

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/710,898

Applicant(s)

FERNANDEZ, JENNIFER

Examiner

Teena Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Objections***

Claims 2 and 3 are objected to because of the following informalities:

In claim 2, lines 11 and 12, "...the mouth receiving outlet..." lacks antecedent basis.

With respect to claim 3, line 5, "...said inhaler body portion..." lacks antecedent basis. Correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson (6,557,737).

Hanson in an inhaler device discloses an inhaler encasement that includes, rectangular body (12) sized in length to encompass with a slight overlap an inhaler body (H) a clip connector (17a; 34a, 34b) and a clip (20) connected to said connector for attaching to a garment. The difference between Hanson and claim 1 is an adhesive on one side of said encasement. Hanson discloses whether connective hook and loop fasteners are utilized, snaps or other connective devices are utilized, the concept of the primary carrier is to provide an inhaler carrier that does not require removal of the inhaler or inhalant unit from the carrier for use (Col. 4, lines 39-47). Therefore it would have been an obvious matter of design consideration to use an adhesive disposed on the encasement body as one means for another inasmuch as adhesive means are well known in the art for attaching purposes, also it is well known to use a protective sheet covering in order to protect the adhesive until time of use. Therefore the use of an adhesive is deemed to be a design consideration, which fails to be patentably distinguish over the prior art of Hanson.

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With respect to the limitation of a spring loaded clip with jaws. It would have been an obvious matter of design consideration to a person of ordinary skill in the art to use a spring loaded clip with jaws because applicant has not disclosed that a spring loaded clip with jaws provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore would have expected Applicant's invention to perform equally well with any clip means, as such clips as alligator and or D shaped clips, are well known in the art for attaching purposes of one item to another. Therefore, it would have been an obvious matter of design consideration to modify Hanson to obtain the invention as specified in claim 1.

With respect to claim 2, Hanson disclosed a hook fastener attached to one end of said flexible sheet (Col. 3, lines 35-40), a fastening loop sized in diameter to fit around the mouth receiving outlet (18; also note rejection of claim 1).

With respect to claim 4, Hanson discloses said connector including a strap (17) with respect to the spring loaded clip, note rejection of claim 1 above.

With respect to claims 5 and 6, note rejection of claim 1 above.

**Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hermanson (5,730,118).**

Hermanson in an inhaler discloses a inhaler body (12) that includes a cylindrical passage and an outlet passage (40) for dispensing medication; a medication container (38) that include a nozzle and spray outlet mountable within said inhaler body (12); a connector (18a) permanently attached to said inhaler body (12). Hermanson discloses a clip (22) but does not disclose a spring-loaded clip with jaws. However, it would have

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been an obvious matter of design consideration to a person of ordinary skill in the art to use a spring loaded clip with jaws because applicant has not disclosed that a spring loaded clip with jaws provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore would have expected Applicant's invention to perform equally well with any clip means, as such clips as alligator and or D shaped clips, are well known in the art for attaching purposes of one item to another. Therefore, it would have been an obvious matter of design consideration to modify Hanson to obtain the invention as specified in claim 1.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of art is cited to show inhalers and fasteners: .6,685,068; 6,223,744; 6,164,275; 5,855,307; 5,833,093; 4,838,466; 6,820,612.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (571) 272-4798. The examiner can normally be reached on Monday-Friday however on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Teena Mitchell  
Examiner  
Art Unit 3743  
December 10, 2004